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In re Application of:	:	
KRAFT, Phillip, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/521,494	:	37 CFR 1.47(a)
PCT No.: PCT/CH03/00466	:	
International Filing Date: 11 July 2003	:	
Priority Date: 20 July 2002	:	
Attorney's Docket No.: 102790-186(30060)	:	
For: FRAGRANCE COMPOSITION	:	

This decision is issued in response to applicants' "Petition To Admit Oath & Declaration Pursuant To 37 CFR 1.47(A)" filed 23 January 2006. Deposit Account No. 14-1263 will be charged the required \$200 petition fee.

**BACKGROUND**

On 11 July 2003, applicants filed international application PCT/CH03/00466. The application claimed a priority date of 20 July 2002 and designated the United States. On 29 January 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent And Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 January 2005.

On 18 January 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 19 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date was required.

On 23 January 2006, applicants filed a response to the Notification Of Missing Requirements (with required three-month extension fee). The submission includes the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Riccardo CADALBERT, whom applicants argue has refused to execute the application.

### DISCUSSION

Where some (but not all) of the inventors fail to execute the declaration, acceptance of the application without the signature of the remaining inventors may be requested pursuant to 37 CFR 1.47(a). A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed below, applicants here have failed to satisfy items (3) and (4).

Regarding item (1), Deposit Account No. 14-1263 will be charged the required \$200 petition fee. Item (1) is therefore satisfied.

As for item (2), the petition expressly states the last known address for the non-signing inventor Riccardo CADALBERT. Accordingly, item (2) is satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by the one of the two inventors with an unsigned signature box for the non-signing inventor. However, applicants have also submitted a copy of the declaration executed on behalf of the non-signing inventor by a representative of the assignee. Because the assignee has executed the declaration on behalf of the non-signing inventor, the declaration filed here cannot be treated as having been signed by the available inventor on his own behalf and on behalf of the non-signing inventor, as required for the declaration to be accepted.<sup>1</sup> The present declaration is therefore unacceptable. Item (3) is not satisfied.

Regarding item (4), applicants assert that the nonsigning inventor has refused to execute the application. Under such circumstances, MPEP § 409.03(d) requires evidence that a copy of the complete application papers have been provided to the nonsigning inventor and "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." The MPEP also states that "[i]f there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted." Here, the evidence submitted by applicants to demonstrate the refusal to execute the application is contained in the declaration of Pascal DE ROUGEMONT, and the accompanying attachments. The statement describes an ongoing correspondence between the assignee and representatives of the non-signing inventor, and includes English translations of correspondence mailed by the

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<sup>1</sup> Where, as here, some of the inventors have executed the declaration, it is impermissible for the assignee to sign on behalf of the others. The assignee can only sign on behalf of the non-signing inventor in cases where none of the inventors has signed the declaration (see 37 CFR 1.47(b)).

assignee (including a letter which states that it includes a copy of the application papers, as required). However, applicants have not provided English translations of the correspondence from the non-signing inventor's attorney. Such translations are necessary, because this correspondence purportedly contains the refusal of the non-signing inventor to execute the declaration. Until an English translation of these materials is submitted, it cannot be determined whether the materials provided are sufficient to demonstrate a refusal to execute the application materials. Item (4) above is therefore not satisfied.

Applicants have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a). Accordingly, the petition cannot be granted on the present record.

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include the materials necessary to satisfy items (3) and (4) of a grantable petition, as discussed above.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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